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IN THE

Supreme Court of the United States

OCTOBER TERM, 1948.

SAMUEL O. BLANC,

Petitioner,

VS.

SPARTAN TOOL COMPANY,

Respondent.

No. 241

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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May It Please the Court:

The grounds relied on by petitioner for a grant of a writ of certiorari by this Court are (1) alleged conflict between the Courts of Appeals for the Seventh and Sixth Circuits, and (2) approval by the Court of Appeals for the Seventh Circuit of the allowance by the District Court pursuant to 35 U. S. C., Section 70, of attorneys' fees to be awarded to the prevailing party.

The respondent contends that there is no genuine conflict in decision between the circuits as to either patent in suit, and that the allowance of attorneys' fees, not yet fixed in amount, pursuant to the cited statute is likewise no ground for the granting of the petition.

RESTATEMENT OF THE FACTS.

No Conflict Exists Between Courts of Appeals as to Infringement of Either Blanc Patent.—The Courts of Appeals for the Sixth and Seventh Circuits are in full agreement with respect to petitioner's lack of right to injunctive relief against the manufacture and sale of standard commercial machines alleged to infringe Blanc patent Re. 22,113. In the latest case to arise in the Sixth Circuit, namely, *Blanc v. Cayo*,* 139 F. 2d 695, the Court of Appeals held claims 4, 5, 7, 8, 9, 10 and 11 of the Blanc machine patent Re. 22,113 to be not infringed by the defendant's machine. The same result, with respect to the same claims of the same patent, was reached by the Court of Appeals for the Seventh Circuit in the instant case with respect to respondent's machine. Cayo's and respondent's machines are substantially identical, as appears from a comparison of the photograph and drawing of Cayo's machine taken from the *Cayo* record, appended at the end of this Brief and marked "Cayo's Machine," with the reproduction of a photograph of respondent's machine (Defendant's Exhibit W-1) appearing at page 247 of the record, also attached at the end of this Brief and marked "Respondent's Machine."

Both Cayo's and respondent's machines comprise, essentially, a flexible shaft, or plumber's snake, colored yellow, coiled in a motor driven cage or container, colored blue, rotatably mounted on a frame, one end of the shaft being led out along the axis of rotation of the container through an anti-kicking or distributor tube, colored red. Cayo's container for the flexible shaft is in the form of

*A copy of the record in the *Cayo* case is in evidence in the instant case as a physical exhibit marked Plaintiff's Exhibit XX.

a slightly tapered cage, whereas defendant's container has no taper and its walls are solid. No difference in operation or function results from this slight variation in the form of the container. Both of these machines have similar parts functioning in the same manner to produce the same results.

In the earlier decision of *Blanc v. Curtis*, 119 F. 2d 395, the Court of Appeals for the Sixth Circuit held that claim 4 of the original Blanc machine patent, No. 2,111,527, which is the same as claim 4 of the reissue patent, was not infringed by Curtis' machine.

No court of appeals has ever held either the original or the reissue patent to be infringed by any commercial machine. The courts of appeals are unanimous in the view that equitable relief should be denied to the petitioner because the claims both of the original and of the reissue patent are too narrow to read on present day commercial machines such as respondent's or Cayo's.

In *Blanc v. Cayo* in the District Court (50 F. Supp. 552, 557), Judge Raymond held claims 4, 5, 7, 8, 9, 10 and 11* of the reissue patent, to be invalid, as well as not infringed. On appeal (139 F. 2d 695) Judge Raymond's decision was affirmed in all respects save as to the invalidity of claim 4. No reason was given in the opinion for this exception, save that the claim had previously been held valid although not infringed in *Blanc v. Curtis*, 119 F. 2d 395. No difference in operation or result exists between claim 4 called valid, and the other claims, to-wit, 5, 7, 8, 9, 10 and 11, held invalid in *Blanc v. Cayo*.

*These same claims were in suit in the instant case and were held invalid and not infringed in both the District Court and in the Court of Appeals.

There is likewise no conflict between courts of appeals on the question of noninfringement of the claims of the Blanc cutter patent by cutters such as those manufactured and sold by this respondent, as illustrated on the drawing, Defendant's Exhibit Y, appearing at page 252 of the record. Figure 2 of this exhibit, showing defendant's cutter, compared with Figure 2 of the drawing of Blanc's patent, clearly discloses the essential difference between the two cutters. Blanc's blades, in the language of claim 3, are "inclined rearwardly relative to their direction of rotation," and respondent's are not, but are exactly opposite each other and in the same plane as their direction of rotation.

In the earlier Sixth Circuit decision of *Blanc v. Curtis*, 119 F. 2d 395, the Court of Appeals had held that the claims of the cutter patent were infringed by Curtis' blades even though they were not "rearwardly" inclined as specified in Blanc's claims. This view, however, was repudiated by the same court in the later case of *Blanc v. Cayo*, 139 F. 2d 695, where the defendant's blades, like respondent's, were not rearwardly inclined. The District Court had held that on account of this lack of rearward inclination, Cayo's blades did not infringe any of the claims of the Blanc cutter patent. In affirming, the Court of Appeals held (139 F. 2d 695, at 696) that "The conclusion reached by the District Court that none of the six claims of the cutter blades in suit are infringed by the cutter blades of appellee's structure *was obviously correct*,"* thus overruling the court's earlier expressed view in *Blanc v. Curtis*. The same conclusion as to noninfringement of the cutter patent was reached in *Blanc v. Weston* in the Eighth Circuit, 109 F. 2d 911, where the Court of

*Emphasis ours.

Appeals affirmed the lower court's ruling that the blades of the defendant's structure, having no rearward inclination, did not infringe the claims of that patent. Thus, in spite of some preliminary fumbblings by the district courts in the Eighth Circuit, the Court of Appeals for that circuit is in entire agreement with the Courts of Appeals for the Sixth and Seventh Circuits in holding that no blades made without rearward inclination infringe the claims of the cutter patent.

All the Elements of Blanc's Machine Patent Are Present in the Prior Art and Function Therein Precisely as in the Patent in Suit.—The petition states (p. 2) that "The entirely new concept of petitioner's machine resides in the fact that in order to cleanly cut roots and other debris from the inner surface of a sewer or tile, it is necessary to build up a high degree of torque within the mechanical spring which, when released, causes the cutter to rapidly spin." There is here an admission of the fact, which the record fully supports, that the prior art disclosed cutting blades mounted on the end of mechanical springs which cut roots in sewers upon the release of torque. Petitioner merely claims that his machine builds up a higher degree of torque than prior machines. In the Patent Office prosecution of the application for his patent, Blanc made the same admission. He said (Rec. p. 222):

"It is true that plumber's snakes when in use will engage an obstruction and be held against rotation and that some tortional strains will be built up therein when the other end is further rotated and that when released some added speed and force will be applied to the cutter. *This was generally known prior to applicant's invention.*" Applicant's inventive

*Emphasis ours.

thought is based on the fact which he has so successfully demonstrated in extensive commercial use that in order to obtain the amount of such torsional strain necessary for cleanly cutting off large roots, the flexible shaft must be twisted to such an extent that there is also produced within the flexible shaft a tendency to kink the shaft."

Thus, petitioner concedes that his claim to invention rests wholly on making prior art machines stronger and capable of doing heavier work. Patentability cannot depend on such a mere difference in degree.

The petitioner also states (p. 2) that his "inventive concept contemplates a particular arrangement of the guide and anti-kinking device with respect to the reel * * *." There is no such "particular arrangement." As the Court of Appeals for the Seventh Circuit held (Rec. p. 553) every element of the Blanc reissue patent is present in the prior art and performs there in combination precisely the same function as in the patent in suit.

The device of the reissue or "machine" patent comprises a reel 28 mounted on a frame, a flexible shaft 49 wound on the reel and with one end secured thereto at 50, the other end being led out through an anti-kinking tube 38-39 through a hub 20 and a flexible guide member 21. As the motor driven reel is rotated, the flexible shaft, with a cutting device at its free end, is fed into the sewer by means of the guide member 21.

Precisely these parts,* performing precisely as in Blanc's machine patent, are found in the prior art patents

*The prior art discloses reels (Wrigley 599,089, Rec. p. 364; Haines 1,842,166, Rec. p. 422) and containers (Kugelman 2,042,407, Rec. p. 488; Yohn 2,037,103, Rec. p. 474) for storing the flexible shaft. Therefore, patentability cannot rest in the choice of one storage means over the other.

to Kugelman 2,042,407 (Rec. p. 488), Yohn 2,037,103 (Rec. p. 474), and Yohn 2,037,104 (Rec. p. 482). These machines are not motor driven but motor drive is disclosed in Biermann 225,391 (Rec. p. 519) and Silberger 1,898,503 (Rec. p. 430).

Kugelman's flexible shaft 1 is wound in a container 3, and is led out through the anti-kinking device 7 and the guide 10. Rotation of the container revolves the flexible shaft and builds up torque in it should the cleaning tool become arrested by an obstruction in the sewer. If the handle 23 is used to rotate the container, torque will not pass beyond the screw 24; if, however, the screw is not tightened and the container is rotated with the palm of the hand, torque is stored throughout the length of the shaft. No function or element of Blanc's reissue patent is lacking in Kugelman save for the unpatentable detail of securing one end of the shaft to the container, and this is disclosed in other prior art patents, as for instance, in Yohn 2,037,103 (Rec. p. 474). This patent shows a flexible shaft or plumber's "snake" 20 coiled in a container with one end secured thereto at 24, the free end, to which the cleaning tool is attached, being led out through the anti-kinking device 26 and the guide 40.

Yohn 2,037,104 (Rec. p. 482) shows a flexible spring or snake coiled in a container with one end led out through the combined anti-kink and guide tube 6 and 6a.

In Yohn '103 the axis of rotation of the snake is perpendicular to that of the container, whereas in Blanc's machine patent, and in Kugelman, and in Yohn '104 these axes coincide. No difference in operation or function results from this difference in arrangement (Rec. pp. 100-1).

The petition is wholly silent as to what "particular arrangement" of parts and functions is present in peti-

tioner's machine which is not present in these prior art patents. Every element and every function is present, and operates, precisely in Blanc as in the prior art.

The Elements of Blanc's Cutter Patent Are Likewise All Found in the Prior Art and Function Therein Precisely as in the Patent in Suit.—The claims in suit (3 and 6) of Blanc patent 2,069,871 call for a cutter having flexible blades with incurved outer ends to avoid their catching in offset portions of the sewer, the blades, as stated in claim 3, being "inclined rearwardly relative to their direction of rotation" and having their cutting edges further rearwardly inclined. The claims also call for blades of "thin and flexible material," and claim 6 calls for the ends of the blades being turned inward to give the so-called "sled runner" effect in riding over offset portions in the sewer.

The prior art is full of cutters having all these characteristics, even assuming that they might be patentable.

The "rearward" inclination of the blades is the element which, after rejection (Rec. p. 229), carried them to allowance (Rec. pp. 231, 237). This feature is supposed to give them a "draw cutting effect" in use (claim 6). But every boy who ever whittled a stick gets this "effect" with an ordinary pocket knife, and it is also disclosed in many prior art sewer cutters.

The Stevenson patent No. 1,163,624 has "rearwardly inclined" blades, and says of them (Rec. p. 391, pat. p. 1, lines 85-96):

" * * * The blades have thick backs, and their inner faces are beveled abruptly from the backs to the cutting edges as illustrated at C. We have discovered that this form of blade is very effective in not only cutting the grease from the sewer wall but in causing

it to break up into fragments, *the curved form of the blade, and the fact that it is inclined or angularly positioned with reference to the plane of rotation, causing it to cut with a shearing action** and also to break up the released portions."

The so-called "sled runner effect," besides being very obvious, is disclosed in many prior art patents, and is specifically mentioned in Hughes 584,508 (Rec. p. 357, pat. p. 1, lines 53-7), where it is said:

"An important advantage is secured by curving the free ends of the blades toward each other — namely, the tool can more readily be inserted, and in pushing it forward it will freely pass by the joints of the pipe or sewer."

Claim 3 of Blanc says that the cutting edges of the blades are still "further inclined rearwardly." So are the cutting edges of every boy's pocket knife and almost every other kind of knife since time immemorial, and so, specifically, are the cutting edges of the sewer cleaning knives of Hughes 584,508 (Rec. p. 356), La Motte 1,915,679 (Rec. p. 436) and Bolla 267,388 (Rec. p. 529).

In sewer cleaning knives the feature of having the blades themselves "rearwardly inclined" with respect to their direction of rotation is wholly unnecessary. Neither respondent's blades nor Cayo's, in the Sixth Circuit, had any such rearward inclination. Respondent and Cayo *chop* off the roots; they do not *slice* them off.

Blanc is estopped to contend that blades like respondent's and Cayo's, having no rearward inclination, infringe his claims. In the prosecution of his application, Blanc first asserted claims not limited to a rearward inclination of the blades (Rec. p. 228), and these claims were rejected

*Emphasis ours.

on Mulliner 1,211,212 (Rec. p. 229) whose blades, like respondent's and Cayo's were not "rearwardly inclined" (Rec. p. 396). Blanc then amended his claims by inserting the limitation requiring the rearward inclination, and they were thereupon allowed (Rec. p. 230). Obviously, the claims, thus limited, cannot be read on respondent's or Cayo's blades, which are in this respect like Mulliner's, and the courts both in the Sixth and Seventh Circuits have so held. A similar holding appears in the opinion of the Court of Appeals for the Eighth Circuit in *Blanc v. Weston*, 109 F. 2d 911.

ARGUMENT.

(1) **There Is No Genuine Conflict Between the Circuit Courts of Appeals as to Either Blanc Patent.**—All the courts of appeals which have considered the Blanc patents are agreed that the machine patent (Re. 22,113) is not infringed by Spartan's machine in the Seventh Circuit, or by Cayo's almost identical machine in the Sixth Circuit, and all are likewise in agreement that no cutters such as respondent's, lacking the rearward inclination of the blades, infringe the claims of Blanc's cutter patent No. 2,069,871.

The Sixth Circuit Court of Appeals was unduly merciful to Blanc in allowing validity of claim 4 of the machine patent in *Blanc v. Curtis*, 119 F. 2d 395, and in *Blanc v. Cayo*, 139 F. 2d 695, the reaffirmation of this view seems to have been on the ground of consistency rather than accuracy. But however that may be, the important fact on this petition is that the unanimous opinion of every court of appeals is that the claims of the Blanc machine patent do not reach a typical modern sewer cleaning device such as Curtis', Cayo's, or respondent's, and that the claims of the cutter patent do not reach cutters such as respondent's, Cayo's or Weston's. Thus, essentially, there is no basic conflict between the circuits. The decisions of the courts have freed the industry from any threat from either patent in the manufacture and sale of standard sewer cutting machines and cutters therefor as exemplified in respondent's or Cayo's structures. Hence, it is of no consequence that

there is lacking complete unanimity of judicial opinion on the moot question of the validity of claim 4 of the machine patent.

In *Layne & Bowler Corporation v. Western Well Works, Inc., et al.*, 261 U. S. 387, in dismissing a writ of certiorari in a somewhat similar case, this Court said (pp. 392-3):

“It is manifest from this review of the conclusions in the two circuits as to the validity of the Layne patent and the proper construction to be put upon the 9th, 13th and 20th claims, that they were really in harmony and not in conflict and that there was no ground for our allowing the writ of certiorari to add to an already burdened docket. If it be suggested that as much effort and time as we have given to the consideration of the alleged conflict would have enabled us to dispose of the case before us on the merits, the answer is that it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal. The present case certainly comes under neither head.”

We submit that the view as to the validity of one claim of the machine patent, expressed as dictum in the opinions of the Sixth Circuit Court of Appeals does not constitute such a “real and embarrassing conflict of opinion and authority” as to justify the issuance of the extraordinary writ of certiorari when there is complete agreement that standard commercial machines and cutters such as respondent’s and Cayo’s do not infringe any claim of either patent.

(2) **The Allowance of Attorneys' Fees as Authorized by Statute is No Ground for the Granting of the Petition.**—The Court of Appeals for the Seventh Circuit approved the District Court's allowance of reasonable attorneys' fees to the successful party; but no award of fees has yet been made. The Court held (Rec. p. 555) that "Under 35 U. S. C. A. §70 the court may in its discretion award reasonable attorneys' fees to the prevailing party," and that until it should appear that as a matter of law there was a clear abuse of discretion, the matter was ended. Until the amount of the fees is determined, there is nothing for any court to pass upon, the power to make the award having been expressly conferred by the statute, and there being no conflict between courts of appeals as to the meaning of the statute.* It has been held many times that the writ of certiorari will not be granted in order to permit the writing of an advisory opinion upon the propriety or validity of statutes (*Muskrat v. United States*, 219 U. S. 346).

In addition to the reasons for denying the petition heretofore given, we submit also that this is a situation where the invalidity of all the claims in suit of both patents, and specifically the invalidity of claim 4 of the reissue patent, is as apparent now as it would be on final hearing should the petition be granted, and that, in consequence, a great saving of the time of this Court and of expense to the parties may be had by a denial of the petition.

*Thus, in *Bianchi v. Barili*, 78 U. S. P. Q. 5, June 15, 1948, the Court of Appeals for the Ninth Circuit held (p. 12) that the award of attorneys' fees under the statute in patent cases was discretionary.

CONCLUSION.

It would seem to be a waste of this Court's time, to say nothing of the serious expense to the respondent, to determine the purely abstract question of the validity of one claim in a patent which nobody uses; and the matter of the award of attorneys' fees is merely a question of statutory interpretation on which no present conflict exists between the circuits, and on which this Court should not be asked to write an advisory opinion. The petition for certiorari should be denied.

Respectfully submitted,

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THORLEY VON HOLST,
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CAYO'S MACHINE





RESPONDENT'S MACHINE

DEFENDANT'S EXHIBIT W-1

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RESPONDENT'S MACHINE

DEFENDANT'S EXHIBIT W-2

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